

REMARKS

Applicants acknowledge receipt of an Office Action dated July 16, 2008. In this response, Applicants have amended independent claim 13 and have added new independent claim 23. Following entry of these amendments, claims 2-13, 18, and 22-23 are pending in the application.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Rejection Under 35 U.S.C. § 102

On page 3 of the Office Action, the PTO has rejected claims 2-4, 6, 8, 9, 18 and 22 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 2,870,235 to Soltis (hereafter "Soltis"). Applicant traverse this rejection for the reason set forth below.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP § 2131.

Here, Soltis fails to disclose "a packing case defining a fixed open space for housing the battery cell, the packing case being provided with an opening to allow access to an inside of the open space and to expose the electrode tab of the battery cell housed in the open space to the outside of the packing case" as recited in amended independent claim 13.

In Soltis, the insulating wrapper (20), which the PTO suggests corresponds to the "packing case" of the presently claimed invention, is flexible (see, for example, col. 2 line 41), and does not define a fixed open space for housing a battery cell. Further, the part of the cell (160), from which the lead (166) protrudes (see Figs. 17 and 18) and which the PTO suggests corresponds to the "opening" of the presently claimed invention, is heat sealed, and does not allow access to the inside of the cell.

For this reason alone, Applicants submit that the PTO's rejection does not properly apply to independent claim 13 or, by extension, to any claim depending therefrom. Applicants submit that the foregoing discussion provides a sufficient basis for withdrawing

the outstanding § 102 and, for this reason do not provide any further comments regarding the outstanding rejection at this time. Applicants expressly reserve their right to present further arguments in the future and do not acquiesce in any aspect of the outstanding rejection.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 102.

Rejection Under 35 U.S.C. § 103

On page 5 of the Office Action, the PTO has rejected claim 5 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 2,870,23 to Soltis (hereafter “Soltis”) in view of U.S. Patent 6,821,671 to Hinton (hereafter “Hinton”). Also, on page 6 of the Office Action, the PTO has rejected claim 7 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 2,870,23 to Soltis (hereafter “Soltis”) in view of U.S. Patent 5,688,615 to Mrotek (hereafter “Mrotek”). Applicants traverse this rejection for the reasons set forth below. In addition, on page 6 of the Office Action, the PTO has rejected claims 10, 11 and 13 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 6,773,848 to Nortoft (hereafter “Nortoft”) in view of U.S. Patent 5,445,856 to Chaloner-Gill (hereafter “Chaloner-Gill”). Applicant traverse this rejection for the reasons set forth below. Finally, on page 8 of the Office Action, the PTO has rejected claim 12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 6,773,848 to Nortoft (hereafter “Nortoft”) in view of U.S. Patent 5,445,856 to Chaloner-Gill (hereafter “Chaloner-Gill”). Applicant traverse these rejections for the reasons set forth below.

The Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.* has not removed the requirement that the prior art reference (or references when combined) must teach or suggest all the claim limitations. Also, MPEP §2143 suggests that prior art must disclose all the features of the claimed invention as all the various rationales suggest that each element of a claim has to be known in the art before it is combined with the primary reference.

Here, Soltis, Hinton, Mrotek, Chaloner-Gill, and Nortoft, whether taken individually or in combination, fail to teach or suggest a “a packing case defining a fixed open space for housing the battery cell, the packing case being provided with an opening to allow access to an inside of the open space and to expose the electrode tab of the battery cell housed in the

open space to the outside of the packing case” as recited in amended independent claim 13. For at least this reason, Applicants submit that the outstanding rejections based upon various combinations of Soltis, Hinton, Mrotek, Chaloner-Gill, and Nortoft are improper and ought to be withdrawn.

Applicants have discussed the deficiencies in Soltis above and incorporate the discussion of those deficiencies by reference here. The remaining references combined with Soltis fail to resolve these fundamental deficiencies.

In Chaloner-Gill, the exterior layers (40, 42), which the PTO suggests correspond to the “packing case” of the presently claimed invention, are flexible (see, for example, col. 4 lines 39-49), and do not define a fixed open space for housing a battery cell. Further, the part of Nortoft's cell (1, 1'), from which the tab (2, 3, 2', 3') protrudes (see Figs. 1a and 1b) and which the PTO suggests corresponds to the “opening” of the presently claimed invention, is heat sealed (see, for example, col. 4 lines 40-51), and does not allow access to the inside of the cell.

For this reason alone, Applicants submit that the PTO's rejection does not properly apply to independent claim 13 or, by extension, to any claim depending therefrom. Applicants submit that the foregoing discussion provides a sufficient basis for withdrawing the outstanding § 103 and, for this reason do not provide any further comments regarding the outstanding rejection at this time. Applicants expressly reserve their right to present further arguments in the future and do not acquiesce in any aspect of the outstanding rejection.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 103.

Newly Added Claim

In this response, Applicants have added new independent claim 24. The references cited in the outstanding rejections fails to disclose the combination of features set forth in independent claim 23.

In Soltis, in the insulating wrapper (20), which the PTO has suggests corresponds to the “packing case” claim 13 (see, for example, col. 2 lines 31-44), only has a single cell

having a power generating element (10, 12, 14) sealed in a cathode collector (16) which the PTO suggests corresponds to the "film" of independent claim 13, is provided.

In Chaloner-Gill, in the exterior layers (40, 42), which the PTO suggests corresponds to the "packing case" of claim 13, only a single battery cell (10) having a power generating element (12, 14, 16) sealed in the interior layers (36, 38), which the PTO suggests corresponds to "film" of claim 13, is provided

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 11/17/08
FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

By P.D.S.
Paul D. Strain
Registration No. 47,369
Attorney for Applicant